BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant (s)	:	TADYCH, John E.
Serial No.	:	10/762,663
For	:	RUBBER MASKING COMPOUND AND METHODS OF USE
Filed	:	January 22, 2004
Examiner	:	MULCAHY, Peter D.
Group Art Unit	:	1713
Confirmation No.	:	5153

CERTIFICATION OF SUBMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted via the Patent Electronic Filing System (EFS) to the U.S. Patent and Trademark Office

Date: September 25, 2007 /Jill S. Polnaszek/

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

APPEAL BRIEF UNDER 37 C.F.R. §41.37

This is an appeal from the final rejection of Claims 1, 2 and 8-15 as stated in the Office Action mailed March 23, 2007. The Notice of Appeal was timely filed on June 25, 2007.

TABLE OF CONTENTS

I. REAL PARTY IN INTEREST

The real party in interest is American Building Restoration Products Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no prior pending related applications or patents under appeal, or the subject of an interference proceeding, or the subject of a judicial proceeding.

III. STATUS OF CLAIMS

All the claims of this application and their individual status are reported in the Claims Appendix to this Appeal Brief. Claims 1-2, and 8-15 are on appeal.

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection and all other amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1, the sole independent claim, is drawn to a masking compound. The purpose of a masking compound is briefly identified on page 2, lines 12-15. The masking compound in claim 1 comprises:

Claim Element	Support Location
forming a stretch wrap film	Described on page 2, lines 17-26.
at least one filler	Described from page 2, line 27 through page 3, line 9.
aqueous ammonia	Described on page 3, line 10-14.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1-2, and 8-15 are unpatentable under 35 U.S.C. §103(a) over Watanabe (US 6,929,857).

VII. ARGUMENT

The Examiner stated in the March 23, 2007 Office Action that it was reasonable to assume that some of the Watanabe et al. latex would be vulcanized in the presence of vulcanizing agents. The Appellant believes that statement is a key to the Examiner's error.

First, The Examiner's statement indicates that the rejection relies on a supposed inherent element in the compound disclosed by Watanabe et al. However, the Examiner has failed to show that the undisclosed elements must be present in the prior art reference. Inherency of an undisclosed element can only be established by showing that the inherency is necessary and inevitable and not merely possible or even probable. *Interchemical Corp. v. Watson*, 111 USPQ 78, 79(d) (D.C. 1956), *aff'd*, 116 USPQ 119 (D.C. Cir. 1958); MPEP §2112. In addition, inherency and obviousness are distinct concepts. *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 USPQ 303, 314 (Fed. Cir. 1983). In order to establish a *prima facie* case of obviousness based on inherent properties, the Examiner must show that the undisclosed properties are not only inevitably and necessarily present, but also that the inherency of the undisclosed properties or elements is obvious to one skilled in the art. *Kloster Speedsteel AB v. Crucible Inc.*, 230 USPQ 81, 88 (Fed. Cir. 1986).

In this case, the necessary presence of vulcanized rubber latex in Watanabe et al., as proposed by the Examiner, has not been established. No vulcanization would be expected if the cross-linking agent of Watanabe was stable at storage conditions. Such stability is implied by the high temperature (120 C or more) disclosed in Watanabe et al. Moreover, even if a trace of vulcanized rubber latex were inherent in Watanabe et al., the Examiner has not presented any evidence that one skilled in the art would find the presence of such vulcanized material obvious.

Second, in the first Office Action the Examiner gave no weight to the fact that the claim is to a masking compound. However, the use of a product has patentable weight when the properties of the product would depend on the use. In this case, the requirement that the invention is a masking compound imparts certain requirements and expectations in comparison to a generic compound or coating. Masking compounds are sacrificial components that are typically applied to protect a part or an area from contact with another compound, e.g., paint, and

are then removed from the part or area. Given that Watanabe et al. teach the formation of a permanent coating, the Examiner's presumption that Watanabe could function as a masking compound is dubious and in error. The doubt over the suitablity of the Watanabe et al. compound to function as a masking compound is further reinforced by the fact that the Watanabe compound requires heating to a high (120+ C), which would render it impractical for many masking operations. Moreover, when the Watanabe compound is vulcanized in accordance with embodiments of that invention, it forms a crosslinked film. The Examiner has not provided evidence that such a crosslinked film could then be successfully applied as a masking in accordance with the current invention.

Third, the Examiner has failed to address the issue of whether using a vulcanized latex would be operational, or use a different principle of operation, for the purposes of Watanabe et al. Again, vulcanization, or crosslinking, *in situ* on the glass fiber appears to be a key principle of operation of the Watanabe et al. reinforcing fiber. Any vulcanized rubber in the Watanabe latex would presumably form defects in the desired coating, as these pre-vulcanized particles would not form a continuous network with the rest of the coating.

In light of the above arguments, Watanabe et al. fail to teach all elements of the current claims, in particular the limitaiton that the rubber latex is vulcanized. Watanabe et al. disclose a reinforcing glass fiber coated with a composition comprising a latex. However, the latex in Watanabe et al. is either self-crosslinking (column 3, lines 33-37) or may include a vulcanizing agent (column 3, line 51). In either case, the latex of Watanbe et al. is not a vulcanized rubber latex, merely a vulcanizable latex. Vulcanization, or crosslinking, *in situ* on the glass fiber appears to be a key principle of operation of the Watanabe et al. reinforcing fiber. In contrast, the invention of the current claims uses a different principle of operation in that the latex is already vulcanized. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Moreover, the cited art does not appear to provide any suggestion as to whether a vulcanized latex would be operational for the purposes of Watanabe et al. If proposed modification would render the prior art invention being modified unsatisfactory for its intended

purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, the Applicant believes that the Examiner's *prima facie* case of obviousness fails.

For all of the reasons presented above, the Appeallant requests that the final rejections be overturned.

VIII. REQUEST

For the reasons stated in the above argument, Appellants believe that the claims on appeal comply with 35 U.S.C. § 103(a), and they request that the final rejection of the claims on appeal be reversed.

Respectfully submitted,

Date: September 25, 2007

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IX. CLAIMS APPENDIX

The claims on appeal are:

1. (Rejected) A masking compound comprising a vulcanized rubber latex, at least one filler and aqueous ammonia.

2. (Rejected) The masking compound of Claim 1 characterized in that a film layer of the compound dries to form an elastic rubber membrane.

3. (Canceled)

4. (Canceled)

5. (Canceled)

6. (Canceled)

7. (Canceled)

8. (Rejected) The masking compound of Claim 1, wherein the vulcanized rubber latex comprises at least one rubber polymer selected from the group consisting of natural or synthetic polyisoprene, sodium polysulfide, polychloroprene, butadiene-styrene copolymers, acrylonitrilebutadiene copolymers, ethylenepropylene-diene rubbers, copolymer of isobutylene and isoprene, polyacrylonitrile, silicone, epichlorohydrin and polyurethane.

9. (Rejected) The masking compound of Claim 8, wherein the rubber polymer is natural polyisoprene or synthetic polyisoprene.

10. (Rejected) The masking compound of Claim 1, wherein the filler comprises at least one of talc, barium carbonate, calcium carbonate, clay, silicon dioxide, aluminum oxide, magnesium oxide, iron oxide, sodium oxide, magnese oxide, barium sulphate, mica, titanium oxide, carbon black, iron red, lithopone, cellulose fiber, christolite fiber, or kaolin.

11. (Rejected) The masking compound of Claim 1, wherein the filler is present in an amount up to about 70 wt% based on the solid content of the masking compound.

12. (Rejected) The masking compound of Claim 1, wherein the filler is present in an amount up to about 50 wt% based on the solid content of the masking compound.

13. (Rejected) The masking compound of Claim 1, wherein the filler is present in an amount up to about 20 wt% based on the solid content of the masking compound.

14. (Rejected) The masking compound of Claim 1, wherein the aqueous ammonia comprises up to about 20 wt% based on the total weight of the masking compound.

15. (Rejected) The masking compound of Claim 1, further comprising a stabilizer.

X. EVIDENCE APPENDIX

NONE.

XI. RELATED PROCEEDINGS APPENDIX

NONE.